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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,754	12/05/2003	Gregory J. Bakos	END-5244	3187

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,754

Applicant(s)

BAKOS ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement filed 2/2/06 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

### *Election/Restrictions*

1. Applicant's election with traverse of Invention I in the reply filed on 8/28/06 is acknowledged. The traversal is on the ground(s) that the present claims are neither independent nor distinct and that both requirements must be satisfied to properly restrict. This is not found persuasive because an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct (MPEP § 806). In the action mailed 2/28/06, the inventions were shown to be distinct in that the apparatus as claimed can be used to practice another materially different process.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 3, 5 – 7, 9, 10 and 18 – 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,389,073 to Imran.

In regards to claims 1 – 3, 5 – 7, 9, 10 and 18 – 20, Imran discloses a guide wire structure (Figure 6) including a flexible elongate first segment (121) of a generally constant diameter; a flexible

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elongate second segment of generally constant diameter; a flexible third segment (126) disposed intermediate the first and second segments, wherein the third segment functions as a hinge and is positioned distally relative to the first and second segments (Figures 4A – 4C), the third segment having a bending moment of inertia less than a bending moment of inertia of the first a segment and the second segment and a generally constant diameter less than that of the first and second segment diameters (Col. 4, lines 64 – 67); a tapered segment of decreasing diameter extending from the first segment to the third segment; and a tapered segment of decreasing diameter extending from the second segment to the third segment (Figure 6). At least one of the first, second, and third segments has a circular cross-section (Figure 7). Imran discloses forming the wire of nitinol (Col. 3, line 1). The Examiner considers the segments having different lengths as being a visual indicator. Imran discloses a sleeve (102) encircling the first and second segments. The third segment is bent and provides an elastic hinge. The third segment is capable of bending between a first position where the first and second segments are axially aligned (Figure 6) and a second position where the first and second segments extend proximally from the third segment and generally parallel one another (Figures 4A – 4C).

***Claim Rejections - 35 USC § 103***

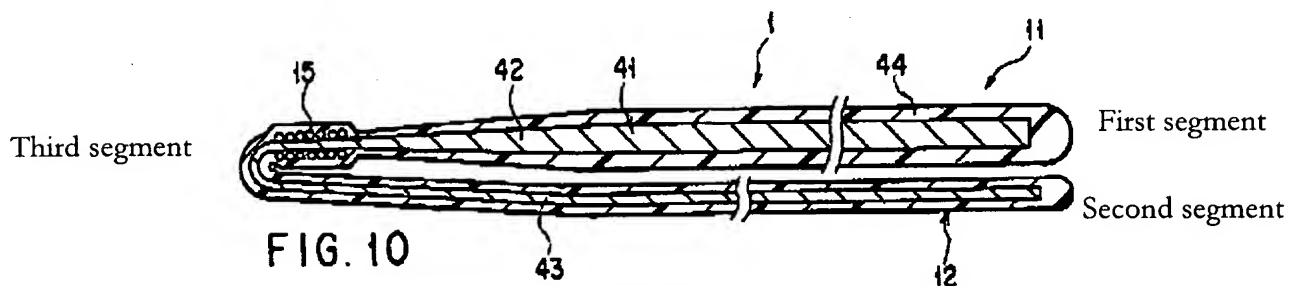
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

Application No. 2002/0087100 to Onuki et al. in view of US Patent No. 5,389,073 to Imran.

In regards to claims 1 - 19, Onuki et al. discloses a guide wire structure (Figure 10) formed including a unitary wire (41) having a flexible elongate first segment, a flexible elongate second segment, and a third segment disposed intermediate the first and second segments.



Onuki et al. discloses at least one of the first, second, and third segments having a circular cross-section or a non-circular cross-section [0118]. Onuki et al. discloses a visual indicator including a marking associated with one of the segments [0109]. Onuki et al. discloses a sleeve (44) encircling each of the first and second segments. The sleeves are visual distinguishable as a result of the size and shape of the sleeve. The combined length of the first segment, the second segment, and the third segment is between about 20 feet [0127][0111]. The first segment has a length of at least about 6 feet and a generally circular cross-section having a diameter of between about 0.011 inch to about 0.035 inch [0111]. In use the third segment is bent and provides an elastic hinge and is positioned distally relative to the first and second segments. Onuki et al. fails to disclose the third segment having a bending moment of inertia less than a bending moment of inertia of the first or second segment. However, Imran discloses a guide wire structure (Figure 6) including first segment (121), a second segment, and a third segment (126) disposed intermediate the first and second segments, wherein the third segment having a bending moment of inertia less than a bending moment of inertia of the first or second segment (Col. 4, lines 64 – 67) and a diameter of between 0.005 inch and about 0.010 inch (Col. 3, line 12). It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to modify the third segment as disclosed by Onuki et al. to have a bending moment of inertia less than a bending moment of inertia of the first or second segment as taught by Imran to ensure that the guide wire bends at the desired position (Col. 5, lines 1 – 5).

### ***Response to Arguments***

6. Applicant's arguments filed 8/28/06 have been fully considered but they are not persuasive. In regards to Onuki et al. in view of Imran, Applicant asserts that neither Onuki et al. nor Imran disclose the third segment functioning as a hinge and being positioned distally relative the first and second segments, the third segment having a bending moment of inertia less than a bending moment of inertia of the first and second segments. However, the Examiner disagrees. In regards to Imran, see above. In regards to Onuki et al., the wire is a thin wire that has been doubled upon itself [0127]. As such, the third segment is positioned distally relative the first and second segment. Because the wire is thin and has become weaker in the area of the bend, the bend is capable of acting as a hinge. Furthermore, Imran teaches reducing the moment of inertia in order to ensure that the guide wire bends at the desired position (Col. 5, lines 1 – 5) leading to a more flexible third segment.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the

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THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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